



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/815,254

03/31/2004

Ezra Jacques Elie Eric Setton

80398P595

7457

8791

7590

06/23/2009

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

EXAMINER

ABRAHAM, ESAW T

ART UNIT

PAPER NUMBER

2112

MAIL DATE

DELIVERY MODE

06/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/815,254	SETTON ET AL.	
	Examiner	Art Unit	
	ESAW T. ABRAHAM	2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 is/are allowed.
- 6) ☒ Claim(s) 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- The reply filed March, 10, 2009, has been received and entered. Claims 21-36 are pending.

Response to Arguments

- Applicant's arguments filed March, 10/2009 have been fully considered but they are not persuasive. Therefore, the rejection under 101, as non-statutory subject matter is maintained.

In response to the rejection of claims 31 and 35, the Applicants argued that "an apparatus comprising means for storing, means for selecting and means for analyzing is not a data structure or a computer program per se" and further the applicant argues that even if the claims are interpreted as computer program per se, applicant does not claim only software modules and the examiner can not force applicant to claim only a specific embodiments. Further, in response to rejection of claim 21, the Applicant argues that since there are alternative means, applicant may elect to claim any one of them and not just any medium. The Examiner respectfully traverses with the following:

With respect to the claim 31 that the apparatus described in the disclosure, paragraph 023 as a transmitter module, 120 located at a content delivery server to transmit the media content is may be a software module since the transmitter module is described in the specification as software, a hardware module or a combination of both the software and the all the "means" claimed in claim 31 can all refer to embodiments which are just software. Claim 31 fails to fall within the statutory category of invention. It is directed to the program itself, not a process (method) occurring as a result of executing the program, a machine programmed to operate in accordance with the program not a manufacture structurally and functionally interconnected with

Art Unit: 2112

the program in a manner which enables the program to act as a computer component and realize its functionality. It is also clearly not directed to a composition of matter. Further, the examiner would like to point out that the applicant must limit the above modules as hardware modules or components **in the specification** in order to fall the claims within statutory category of inventions.

With respect to the claim 35 that the apparatus described in the disclosure, paragraph 023 as a receiver module, 140 located at a client to receive the media content stream is may be a software module since the receiver module is described in the specification as software, a hardware module or a combination of both the software and hardware and the all the "means" claimed in the claim 35 can all refer to embodiments which are just software. Claim 35 fails to fall within the statutory category of invention. It is directed to the program itself, not a process (method) occurring as a result of executing the program, a machine programmed to operate in accordance with the program not a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It is also clearly not directed to a composition of matter. Further, the examiner would like to point out that the applicant must limit the above modules as hardware modules or components **in the specification** in order to fall the claims within statutory category of inventions.

With the respect to claim 21, the examiner would like to point out that the applicant must define the medium in the specification **as tangible embodiments** such as "floppy diskette, compact disk, optical disk **not intangible embodiments** such as "fiber optic medium and a radio

Art Unit: 2112

frequency link”. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Status of Claims

1. Claims 1-20 have been previously allowed.
2. Claims 21-36 remain pending.

Specification

3. The disclosure is objected to because of the following informalities: there is insufficient antecedent basis for support of claims 21-30 language. The specification lacks support for a “machine accessible storage medium”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 21-30 are rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims fail to comply with having an adequate written description for the following reasons.

For example; The claims refer to a "**machine-accessible storage medium**" which is not described/defined in the specification. Note: the specification only teaches or describes "**machine-accessible medium**" not a machine-accessible **storage** medium.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims **31 and 35** are nominally drawn to an "apparatus" comprising "means for storing, means for selecting, means for analyzing" (as in claim 31) means for receiving, means for providing feedback information and means for decoding (as in claim 35) are sub software modules within the transmitter (120) and receiver (140) modules. The applicant disclosure paragraph 023 teaches that "The transmitter 120 is a module located at a content delivery server to transmit the media content 110 to the receiver 140. The transmitter 120 may be a software module, a hardware circuit, or a combination of both hardware and software. Instant claims 1 and 31 are not limited, however, to any tangible embodiment. The "input/output module, a generator, and a decoder of the apparatus of claim 8 is depicted as boxes comprising "apparatus" or "receiver" 140 Figure 3. The applicant disclosure paragraph 025 teaches "the receiver 140 is a module located at a client to receive the media content stream. The receiver 140 may be a software module, a hardware circuit, or a combination of both hardware and software". Claims 31 and 35 fail to fall within the statutory category of invention. It is directed to the program itself, not a process (method) occurring as a result of executing the program, a machine programmed to operate in accordance with the program not a manufacture structurally and

Art Unit: 2112

functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It is also clearly not directed to a composition of matter. Therefore, thus claims are non-statutory as these claims are directed toward "software per se".

Claims **32-36** depend from claims 31 and 35 and therefore are also rejected for the same reasons as cited for claims 31 and 35.

6. Claims **21-30** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For example the Applicant's disclosure, paragraph [0074] teaches "The processor readable or accessible medium" or "machine readable or accessible medium" may include any medium that can store, transmit, or transfer information. Examples of the processor readable or **machine accessible medium** include an electronic circuit, a semiconductor memory device, a read only memory (ROM), a flash memory, an erasable ROM (EROM), a floppy diskette, a compact disk (CD) ROM, an optical disk, a hard disk, **a fiber optic medium, a radio frequency (RF) link, etc.** The computer data signal may include any signal that can propagate over a transmission medium such as electronic network channels, optical fibers, air, electromagnetic, RF links, etc. The code segments may be downloaded via computer networks such as the internet, Intranet, etc.

As such, the claims are not limited to statutory subject matter since the medium **can be a software**, hardware or firmware and are therefore non-statutory. Additionally, the claims lack accomplishing a practical application such as producing a useful, concrete tangible result.

Claims **22-27, 29 and 30** depend from claims 21 and 28 and therefore are also rejected for the same reasons as cited for claims 21 and 28.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esaw T. Abraham whose telephone number is (571) 272-3812. The examiner can normally be reached on M-F 8am-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Baderman can be reached on (571) 272-3644. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2112

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Esaw Abraham/
Primary Examiner, Art Unit 2112